

REMARKS

Claims to non-elected inventions have been canceled.

Claim 1 has been amended to clarify that the “compound with enhanced optical purity” is the resultant of treating the compound of formula (1) with a peptide deformylase. This was the original intent of the claim and does not change its scope. It merely clarifies the wording. No new matter has been added and entry of the amendment is respectfully requested.

Formal Matters

The specification has been amended to refer to its status as the national phase of a PCT based on a European application, as verified by the papers accompanying the filing of this application.

Applicants note the comment that “SEQ ID NO: 1 of the sequence list filed on 1/09/02 is not identified.” This sequence listing clearly identifies SEQ ID NO: 1 as HisGluX_{aa}X_{aa}His, consistent with claim 5 as amended at that time. (That submission amended claim 5 as well. Claim 5 as submitted herein is designated “currently amended” due to correction of an error in the 9 January 2002 paper.) A copy of the 9 January 2002 submission is attached for the convenience of the Office.

The Rejections Under 35 U.S.C. § 112, First Paragraph, Written Description, Enablement

Claims 1 and 4-11 were rejected as failing to meet the requirements of 35 U.S.C. § 112, first paragraph. In reviewing the rationale for this rejection, it appears that the Office has interpreted this claim as reading on the preparation of any compound at all with enhanced optical purity. This is not, and never was, the intent of claim 1. Claim 1 has been amended to clarify the nature of the

subject matter claimed. In view of this clarifying amendment, it is respectfully submitted that the rejection may be withdrawn.

The Rejection for Obviousness-Type Double-Patenting

Claims 1 and 4-11 were provisionally rejected as obviousness-type double-patenting over application No. 09/869,067. Enclosed herewith is a terminal disclaimer with respect to this application, thus obviating the double-patenting rejection.

Claims 1 and 4-11 were rejected as obviousness-type double-patenting over claims 1-2 of U.S. patent 6,617,127. A terminal disclaimer with respect to this patent will be submitted, pending reassignment of the '127 patent to the assignee herein.

CONCLUSION

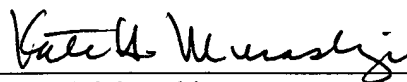
The claims have been amended to clarify that the compound with enhanced optical purity is the compound inevitably resulting from treating the compound of formula (1) (clearly defined and enabled) with a peptide deformylase. Accordingly, the rejection for lack of withdrawn/enableness is obviated. Terminal disclaimers are proposed to obviate the obviousness-type double-patenting rejections. Accordingly, it is believed that upon submission of the terminal disclaimer with respect to U.S. 6,617,127, the pending claims, claims 1 and 4-11, will be in a position for allowance. Passage of these claims to issue is respectfully requested.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 246152014500.

Respectfully submitted,

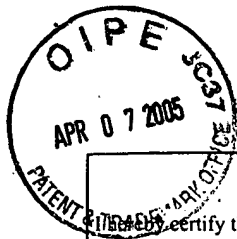
Dated: April 5, 2005

By: _____



Kate H. Murashige
Registration No. 29,959

Morrison & Foerster LLP
3811 Valley Centre Drive,
Suite 500
San Diego, California 92130-2332
Telephone: (858) 720-5112
Facsimile: (858) 720-5125



PATENT
Docket No. 246152014500

CERTIFICATE OF MAILING BY "FIRST CLASS MAIL"

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
Assistant Commissioner for Patents, Washington, D.C. 20231, on November 16, 2001.

U. Britva
Irina Britva

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Peter QUAEDFLIEG et al.

Serial No.: 09/869,088

Filing Date: June 19, 2001

For: PROCESS FOR PREPARATION OF
COMPOUNDS WITH ENHANCED
OPTICAL PURITY

Examiner: To be Assigned

Group Art Unit: 1626

COPY

**RESPONSE TO NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT
APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID
SEQUENCE DISCLOSURES**

Box Missing Parts
Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This is in response to the Notice to comply with requirements for patent applications containing nucleotide sequence and/or amino acid sequence disclosures dated September 20, 2001, for which a response is due on November 20, 2001. Accordingly, this response is timely filed.

Please enter the following Sequence Listing, amendments and remarks.

In the Sequence Listing:

Please insert the attached paper copy of the Sequence Listing as new pages 1-2 in the above-captioned application. A computer-readable copy (CFR copy) of the Sequence Listing accompanies this response.

AMENDMENT

In the Specification:

Please replace the paragraph beginning at page 4, line 23, with the following rewritten paragraph:

--Although the family of PDF's is composed of proteins with a relatively low level of sequence identity, the 3D structures of the members of this family appear closely related one to each other with, in particular, the building of a common fold around the bivalent metal ion and three signature sequences. As is described (for PDF's indicated as PDF) by Wagner et al., J. Biol Chem., 273, 11413-6 (1998), for many of these enzymes characteristically three short amino acid stretches are present as strictly conserved motifs, namely in that they contain the sequences (i) HEXXH (SEQ ID NO:1), (ii) EGCLS (SEQ ID NO:2) and (iii) GXGXAAXQ (SEQ ID NO:3). In these sequences X represents any natural amino acid, and standard one letter codes for amino acids are used: A = alanine, C = cysteine, E = glutamic acid, G = glycine, H = histidine, L = leucine, S = serine and Q = glutamine.--

In the Claims:

Please amend claim 5 as follows:

5. (Amended) Process according to any of claims 1-4, wherein the peptide deformylase contains the sequences of (i) HEXXH (SEQ ID NO:1), (ii) EGCLS (SEQ ID NO:2) and (iii) GXGXAAXQ (SEQ ID NO:3).

REMARKS

The Specification and Claims have been amended to include sequence identification numbers which were omitted at the time of filing.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version with markings to show changes made".

The undersigned hereby states that the computer readable form copy (CRF copy) of the Sequence Listing and the paper copy of the Sequence Listing, submitted in accordance with 37 C.F.R. § 1.825(a) and (b), respectively, are the same and contain no new matter. Accordingly, entry of the Sequence Listing into the above-captioned case is respectfully requested.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 246152014500. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

Dated: November 16, 2001

By: Kate H. Murashige
Kate H. Murashige
Registration No. (29,959)

Morrison & Foerster LLP
3811 Valley Centre Drive
Suite 500
San Diego, California 92130-2332
Telephone: (858) 720-5112
Facsimile: (858) 720-5125



"Version with markings to show changes made"

In the Specification:

Paragraph beginning at page 4, line 23, has been amended as follows:

Although the family of PDF's is composed of proteins with a relatively low level of sequence identity, the 3D structures of the members of this family appear closely related one to each other with, in particular, the building of a common fold around the bivalent metal ion and three signature sequences. As is described (for PDF's indicated as PDF) by Wagner et al., J. Biol Chem., 273, 11413-6 (1998), for many of these enzymes characteristically three short amino acid stretches are present as strictly conserved motifs, namely in that the contain the sequences (i) HEXXH (SEQ ID NO:1), (ii) EGCLS (SEQ ID NO:2) and (iii) GXGXAAXQ (SEQ ID NO:3). In these sequences X represents any natural amino acid, and standard one letter codes for amino acids are used: A = alanine, C = cysteine, E = glutamic acid, G = glycine, H = histidine, L = leucine, S = serine and Q = glutamine.

In the Claims:

Claim 5 has been amended as follows:

5. (Amended) Process according to any of claims 1-4, wherein the peptide deformylase contains the sequences of (i) HEXXH (SEQ ID NO:1), (ii) EGCLS (SEQ ID NO:2) and (iii) GXGXAAXQ (SEQ ID NO:3).



SEQUENCE LISTING

<110> DSM N.V.
Quaedflieg, Peter
Sonke, Theodorus
Wagner, Adolf

<120> PROCESS FOR PREPARATION OF COMPOUNDS
WITH ENHANCED OPTICAL PURITY

<130> 24615-20145.00

<140> US 09/869,088

<141> 2001-06-19

<150> PCT/NL 99/00783

<151> 1999-12-17

<160> 3

<170> FastSEQ for Windows Version 4.0

<210> 1

<211> 5

<212> PRT

<213> Unknown

<220>

<223> Strictly conserved motif of peptide deformylase

<221> VARIANT

<222> (1)...(5)

<223> Xaa = Any Amino Acid

<400> 1

His Glu Xaa Xaa His

1

5

<210> 2

<211> 5

<212> PRT

<213> Unknown

<220>

<223> Strictly conserved motif of peptide deformylase

<400> 2

Glu Gly Cys Leu Ser

1

5

<210> 3

<211> 8

<212> PRT

<213> Unknown

COPY

<220>

<223> Strictly conserved motif of peptide deformylase

<221> VARIANT

<222> (1)...(8)

<223> Xaa = Any Amino Acid

<400> 3

Gly Xaa Gly Xaa Ala Ala Xaa Gln

1

5